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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/438,994	11/12/1999	JAMES J. FORT,	6487.US.01	1116

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EXAMINER	
VENKAT, JYOTHSNA A	
ART UNIT	**PAPER NUMBER**
1615	

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/438,994	FORT, ET AL.	
	Examiner	Art Unit	
	JYOTHSNA A. VENKAT Ph. D	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 July 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,8-10,13-15 and 22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,8-10,13-15 and 22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of response filed on 7/17/06. Claims 1, 8-10, 13-15 and 22 are pending in the application and the status of the application is as follows:

Response to Arguments

Applicant's arguments with respect to claims 1, 8-10, 13-15 and 22 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

Claims 1, 8-10, 13-15 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Article by Palmier et al. in S.T. P. Pharma Sciences, pp 188-194 (1996) (Palmier et al.) and U. S. Patent 5,545,628 ('628).

The instant application is claiming a pharmaceutical composition comprising:

1. A solid dispersion of fenofibrate or a salt or ester there of

2. Hydroxypropylmethylcellulose (HPMC)

3. Polyethylene glycol (PEG) carrier

a method of preparing the composition and method of treating hyperlipidemia comprising administering the composition.

Palmier et al. teaches dissolution studies of Fenofibrate solid dispersions using Fenofibrate and PEG 4000 in solvent ethanol. See page 188, where the article teaches that Fenofibrate is water insoluble molecule and is very soluble in ethanol and the article teaches PEG 4000 as a carrier because of its ethanol solubility and physiologically compatibility. Claims13 and 18 use ethanol as solvent. The difference between the article and the application is article does not teach ingredient 2 for the preparation of solid dispersions. However patent '628

teaches pharmaceutical compositions containing fenofibrate. See col.1, lines 5-10, see col.2, lines 39-55 and see specially lines 50-51 where the patent teaches that HPMC is a suspension stabilizer which avoids the formation of fenofibrate crystals. This is same as claimed HPMC as the crystallization inhibitor. See col.3, lines 1-35 for surfactants. See col.4, lines 1-30 for the preparation and packing into the hard gelatin capsules, see col.7 lines 10-15 where the patent teaches HPMC with fenofibrate. See also pharmokinetical study. Patent does not teach tablet. Dosage forms in the form of tablets, capsules are conventionally used and preparing the compositions in the form of tablet is obvious to one of ordinary skill in the art.

Accordingly it would have been obvious to one of ordinary skill in the art to prepare fenofibrate composition taught by Palmier etal. article using ethanol as solvent and PEG as the carrier and adding HPMC so that solid dispersions are formed. One of ordinary skill in the art would be motivated to add HPMC in fenofibrate dispersions of Palmier et al. with the reasonable expectation of success that HPMC avoids the formation of Fenofibrate crystals. This is a prima facie case of obviousness.

Claims 1, 8-10, 13-15 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Article by Palmier et al. in S.T. P. Pharma Sciences, pp 188-194 (1996) (Palmier et al.) and U. S. Patent 6,465,011 ('011).

The instant application is claiming a pharmaceutical composition comprising:

1. A solid dispersion of fenofibrate or a salt or ester there of

2. Hydroxypropylmethylcellulose (HPMC)

3. Polyethylene glycol (PEG) carrier

a method of preparing the composition and method of treating hyperlipidemia comprising administering the composition.

Palmier et al. teaches dissolution studies of Fenofibrate solid dispersions using Fenofibrate and PEG 4000 in solvent ethanol. See page 188, where the article teaches that Fenofibrate is water insoluble molecule and is very soluble in ethanol and the article teaches PEG 4000 as a carrier because of its ethanol solubility and physiologically compatibility. Claims are also using ethanol as solvent. The difference between the article and the applicati'011 teaches pharmaceutical compositions containing fenofibrate dispersions. See col.2, lines 40 et seq, see col.2, lines 5-19 for solvent which includes ethanol and see the same column, lines 20-25 for HPMC as the amorphous polymer. See col.3, lines 30-31 for capsule and tablet. Patent at col.3, lines 25-30 teach that additional excipients can be used. Patent does not teach the limitation of claim 10. Antioxidants are added to dosage forms/compositions in order to preserve the shelf life.

Accordingly it would have been obvious to one of ordinary skill in the art to prepare fenofibrate composition taught by Palmier article using ethanol as solvent and PEG as the carrier and adding HPMC so that solid dispersions are formed. One of ordinary skill in the art would be motivated to add HPMC in fenofibrate dispersions of Palmier et al. with the reasonable expectation of success that the solid dispersions have increasing bioavalibilty. This is a prima facie case of obviousness.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection

is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,8-10 and 22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3and 5-9 of U.S. Patent No. 6,465,011 ('011) in view of Palmier article.

Instant application and claims to the patent are claiming compostions, dosage forms in the form of capsule or tablet and method of treating hyperlipidemia using fenofibrate and amorphous polymer, which is HPMC. Instant application is also claiming PEG as the carrier, which is not claimed in the patent. Palmier article teaches Fenofibrate dispersions using PEG 4000 as the carrier. It would be obvious to prepare compostions of '011 claimed in the patent and add PEG with the reasonable expectation of success that increased dissolution and increased bioavailability of Fenofibrate dispersions is obtained.

Claims 1, 8-10 and 22 are directed to an invention not patentably distinct from claims 1-3 and 5-9 of commonly assigned 6,465,011 ('011). Specifically, for the reasons stated in 103 and obviousness-type double patenting rejection.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned '011, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. **In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter**.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JYOTHSNA A VENKAT Ph. D
Primary Examiner
Art Unit 1615

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